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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,818

03/15/2004

Steven M. Hurson

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1624

20995

7590

10/03/2006

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EXAMINER

BUMGARNER, MELBA N

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/800,818

Applicant(s)

HURSON, STEVEN M.

Examiner

Melba Bumgarner

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-49 and 52-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-49 and 52-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 37-49 and 52-67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-21 of U.S. Patent No. 6,733,291.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patent lies in the fact that the patented claims include more elements and are thus more specific. Since, the claims of the patent are in effect a species of the generic invention of the claims of this application, the claims of the application are not patentably distinct from the patented claims.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 48, 49, 61, and 63-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe the ratio of the radius of the bottom surface (of the upper region) to the radius of the protrusion between approximately 5:1 and 4:1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 37-49 and 52-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 37 and 56, it is unclear whether the post defined as extending below the interlock region is intended to have a length measured from the bottom surface of the upper region, i.e. including the interlock region. In claim 41, reads (first region) having a diameter smaller than the first region. Recitation of “the bottom surface of the abutment” in claims 48 and 63 lacks sufficient antecedent basis. In claims 52-55, it is unclear whether the dental implant is intended to be positively claimed in that features of the implant are further limited.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 37, 40-42, 47, 52, 55, and 56 are rejected as understood, under 35 U.S.C. 102(e) as being anticipated by Duerr et al. (5,823,776). Duerr et al. disclose a dental abutment comprising an upper region comprising a bottom surface 36, an interlock region extending below the bottom surface comprising a non-threaded cylindrical portion 38 and plurality of semi-circular protrusions 46 arranged around a periphery of the portion, the cylindrical portion has a first radius and the protrusions have second radius, a ratio of the first radius to the second radius approximately 4:1, the interlock region as a length, and a non-threaded post 44 extending below the interlock region, the post having a length (figures 2, 5b). Patentable weight is not given to inferentially claimed dental implant. The abutment comprises an inner bore including a first region, second region, and a seat.

9. Claims 37, 40-43, 52, and 56 are rejected as understood, under 35 U.S.C. 102(b) as being anticipated by Klardie et al. (5,782,918). Klardie et al. disclose a dental abutment comprising an upper region 43 comprising a bottom surface, an interlock region extending below the bottom surface comprising a non-threaded cylindrical portion 52 and plurality of semi-circular protrusions 51 arranged around a periphery of the portion, the cylindrical portion has a first radius and the protrusions have second radius, a ratio of the first radius to the second radius between approximately 4:1 and 2:1, the interlock region as a length, and a non-threaded post 60 extending below the interlock region, the post having a length (figure 4). Patentable weight is not

given to inferentially claimed dental implant. The abutment comprises an inner bore including a first region, second region including capture threads, and a seat.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 38, 39, 43-46, 48, 49, 53, 54, and 57-67 are rejected as understood, under 35 U.S.C. 103(a) as being unpatentable over Duerr et al. Duerr et al. disclose an abutment that shows the limitations as described above; however, they do not show a specific ratio of the radii. It would have been obvious to one of ordinary skill in the art as to a specific ratio within an acceptable range and the specific ratio is not disclosed as critical to the claimed invention. It would have been an obvious matter of choice to one of ordinary skill in the art as to the minimum distances of a region, type of threading and number comprising plurality as the claiming the specific values are preferred limitations of the claimed invention.

12. Claims 38, 39, 44-49, 53-55, and 57-67 are rejected as understood, under 35 U.S.C. 103(a) as being unpatentable over Klardie et al. Klardie et al. disclose an abutment that shows the limitations as described above; however, they do not show a specific ratio of the radii. It would have been obvious to one of ordinary skill in the art as to a specific ratio within an acceptable range and the specific ratio is not disclosed as critical to the claimed invention. It would have been an obvious matter of choice to one of ordinary skill in the art as to the

minimum distances of a region, type of threading and number comprising plurality as the claiming the specific values are preferred limitations of the claimed invention.

***Conclusion***

13. Any inquiry concerning this communication from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melba Bumgarner  
Primary Examiner